

JAN 17 2006

PTO/SB/33 (07-05)

Approved for use through 10/20/200x. OMB 0651-000X

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Docket Number (Optional)

03226/558001; P6570

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Application Number
09/895,530-Conf.
#8174Filed
June 29, 2001First Named Inventor
Brian RasmussenArt Unit
2134Examiner
J. R. Adams

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant /inventor.



Signature

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b)
is enclosed. (Form PTO/SB/06)

Robert P. Lord

Typed or printed name

attorney or agent of record.

Registration number 48,479

(713) 228-8600

Telephone number

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34.

January 17, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of 1 forms are submitted.

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted by facsimile to the Patent and
Trademark Office, facsimile no. (571) 273-9300, on the date shown below.

Dated: January 17, 2006

Signature:



Jaime M. Malley

JAN 17 2006

Docket No.: 03226/558001; P6570

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted by facsimile to the Patent and Trademark Office, facsimile no. (571)273-8300, on the date shown below.

Dated: January 17, 2006 Signature: 
(Jaime M. Malley)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Brian Rasmussen

Conf. No.: 8174

Application No.: 09/895,530

Art Unit: 2134

Filed: June 29, 2001

Examiner: D. Y. Jung

For: **SMART CARD SECURITY FOR COMPUTER
SYSTEM**

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Claims 1-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over online publication www.entrust.com/news/files/5312.htm (hereinafter "Entrust") in view of "Microsoft Windows NT Server" (hereinafter "NTS"), "NT File System Security and Auditing" (hereinafter "FSSA") and "Windows 2000 Advanced Documentation" (hereinafter "Win2000"). In maintaining the above rejection and issuing a final office action, the Applicant respectfully asserts that the Examiner has failed to satisfy the requirements set out in MPEP §2143 and MPEP §707.07(f).

As an initial matter, Applicant notes that in the Advisory Action dated December 15, 2005, the Examiner has not explained with any detail why Applicant's arguments in the final Office Action response dated October 21, 2005, are unpersuasive. Applicant believes

Application No.: 09/895,530

Docket No.: 03226/558001; P6570

this action does not completely and sufficiently answer all material traversed. Accordingly, Applicant asserts the action does not satisfy the requirements of §MPEP 707.07(f).

Secondly, Applicant notes that various combinations of one or more of four references have been used in rejecting the claims of the present application. The purported reconstruction of the claimed invention by reliance on such a large number of references is not appropriate. It is abundantly clearly that the Examiner, using the present application as a guide, has selected isolated features of the various relied-upon references to arrive at the limitations of the claimed invention. Use of the present application as a "road map" for selecting and combining prior art disclosures is wholly improper. *See Interconnect Planning Corp. v. Feil*, 774 F.2d 1132 (Fed. Cir. 1985) (stating that "[t]he invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time"); *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992) (stating that "it is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious This court has previously stated that 'one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'"); *In re Wesslau*, 353 F.2d 238 (C.C.P.A. 1965) (stating that "it is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art").

On a tertiary note, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the

Application No.: 09/895,530

Docket No.: 03226/558001; P6570

art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. (See MPEP §2143).

NTS is directed towards the security architecture and features of the Windows NT Server Operating System. NTS discloses that users may use a security token (e.g., a smart card) to log into a system, where upon validation of the security token, the system imposes access restrictions. (See NTS at pages 22-24). Thus, NTS discloses that a smart card is only used for authenticating, not authorizing, the user. Once authenticated (using the smart card or any other means), the user's access is restricted by an access profile already in existence on the system. (See NTS at pages 47 and 51). Thus, the user's access restrictions, as disclosed by NTS, are embedded on the system, not within a smart card.

In contrast, Entrust discloses a smart card providing multiple security levels. The Examiner asserts Entrust discloses access restrictions embedded within a smart card as recited in independent claims 1, 15, and 16. (See Office Action dated August 25, 2005, at pages 2 and 3). Thus, Entrust discloses a situation where a user's access restrictions are embedded within a smart card, not on the system.

As NTS discloses access restrictions embedded on the system and not within a smart card, while Entrust discloses access restrictions embedded within a smart card and not on the system, Applicant respects there is no motivation to combine the teachings of Entrust with the teachings of NTS. To properly combine references, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must *both* be found in the prior art, *not* in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (emphasis added). Further, the mere fact that references can be combined or modified does

Application No.: 09/895,530

Docket No.: 03226/558001; P6570

not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). In other words, there must be some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

Applicant acknowledges both NTS and Entrust address issues pertaining to security and smart cards generally, but as NTS and Entrust use smart cards in conflicting fashions (*i.e.*, access restrictions are embedded in different locations), Applicant asserts there is no motivation to combine NTS and Entrust. In fact, a complete study of NTS and Entrust confirms that, regardless of whether the teachings of NTS and Entrust can be combined, there is no suggestion or motivation set forth in either NTS or Entrust to combine the teachings of these references. Absent such a suggestion or motivation, the teachings of NTS and Entrust cannot be conveniently combined to render the claimed invention obvious.

In view of the above, Applicant respectfully asserts the Examiner has failed to establish a *prima facie* case of obviousness because any motivation to combine NTS and Entrust is unrealistic. FSSA and Win2000 do not cure the lack of motivation to combine NTS and Entrust. Accordingly, claims 1-21 are patentable over Entrust, NTS, FSSA, and Win2000.

Application No.: 09/895,530

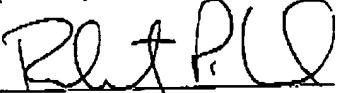
Docket No.: 03226/558001; P6570

Conclusion

In view of the above, the Examiner has failed to satisfy the requirements set out in MPEP §2143 and MPEP §707.07(f). Accordingly, a favorable decision from the panel is respectfully requested. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 03226/558001).

Dated:

Respectfully submitted,

By 

Robert P. Lord
Registration No.: 46,479
OSHA · LIANG LLP
1221 McKinney St., Suite 2800
Houston, Texas 77010
(713) 228-8600
(713) 228-8778 (Fax)
Attorney for Applicant